IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.:	09/370,619	Confirmation No.:	8285
Applicant:	Michael D. Erlanger		
Title:	EFFICIENT MARKET FOR FINANCIAL PRODUCTS		
Filed:	August 7, 1999		
Art Unit:	3624		
Examiner:	Ella Colbert		
Atty. Docket:	114459-05		
Customer No.	38492		

CORRECTED RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By this paper, Applicant responds to the Restriction Requirement of August 11, 2005 and respectfully requests consideration of the application.

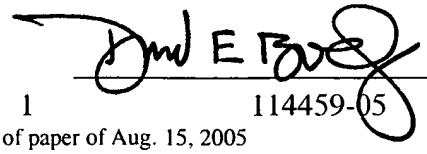
Claims 186-303 are now pending, a total of 117 claims. Claims 186, 187, 213, 225, 241, 252, 264, 282, 287, and 294 are independent. Applicant's election with traverse is set forth in § IV at page 3, below.

I. Applicant Responds Under MPEP § 803.01

Applicant responds in the manner provided in MPEP § 803.01, in which the Director instructs as follows (capitals in original):

> Since requirements for restriction under 35 U.S.C. 121 are discretionary with the Commissioner, it becomes very important that the practice under this section be carefully administered. ... IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION. ...

I certify that this correspondence, along with any documents referred to therein, is being deposited with the United States Postal Service on December 6, 2005 as First Class Mail in an envelope with sufficient postage, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



MPEP § 803.01 may be the only place in the MPEP where the Director issues instructions in ALL CAPITALS. The Director intended to remove all doubt that there is no discretion to restrict among claims to the same invention.

The Director's "important" instruction applies to this application as follows:

- Claims 186 and 300 recite inventions that are intended to be identical or nearly identical to each other. Thus, Group I and Group II must not be restricted from each other.
- Claims 299 and 302 recite inventions that are intended to be identical or nearly identical to each other. Thus, Groups II and III must not be restricted from each other.
- Claims 301 and 303 recite inventions that are intended to be identical or nearly identical to each other. Thus, Groups III and IV must not be restricted from each other.
- Claims 266 and 296 recite inventions that are intended to be identical or nearly identical to each other. Thus, Groups IV and V must not be restricted from each other.

II. Applicant Responds Under MPEP § 803

MPEP § 803 reads as follows:

> If there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required. *In re Lee,* 199 USPQ 108 (Comm'r Pat. 1978).

Applicant responds pursuant to with the following "express admissions:"

- Claims 186 (Group I) and 300 (Group II) are obvious over each other.
- Claims 299 (Group II) and 302 (Group III) are obvious over each other.
- Claims 301 (Group III) and 303 (Group IV) are obvious over each other.
- Claims 266 (Group IV) and 296 (Group V) are obvious over each other.

The MPEP leaves no discretion: these groups must be examined together.

III. The August 2005 paper does not deal with the currently-pending issues, and remains too incomplete to raise any requirement for restriction

Applicant notes that the "express admissions" set forth in § II of this paper were set forth in the paper of May 2005, and Applicant noted that all claims were therefore properly considered one group. The examiner's paper of August 2005 fails to acknowledge these "express admissions," or to "Answer All Material Traversed."

Page 6 proposes to search Group IV in 705/30. This is clearly incorrect. Subclass 30 is directed to "accounting." At least the independent claims of this group, claims 264 and 282,

recite no words normally associated with "accounting" such as "asset," "liability," "credit," "debit," "revenue," "cash flow," "income," "earnings," "balance sheet," or the like. With no visible relationship to the discipline of "accounting," it is clear that the classification of Group IV is simply incorrect. Various aspects of Group IV should be searched in 705/1, 705/35, 705/36, 705/37 and 705/38, with 705/35 being the single best classification. Under a correct classification, Group IV should be included with one of the other groups.[4]

The August 2005 Action is incomplete. There is no showing of distinctness of Group I from any other group. There is no showing of distinctness between Groups II and IV, or between Groups II and V. At pages 7-8, there is only a showing of 1-way distinctness between Groups II and III, where MPEP § 806.05(c) requires a 2-way showing. There is accordingly no requirement among Group I, Group II, and any other Group. Therefore, the election of Group II (see below) constitutes an election of all claims.

The "linking claim" and "combination/subcombination" relationships set out in the Office Action are incorrect. In the unlikely event that the Restriction Requirement is maintained in spite of MPEP §§ 803 and 803.01, Applicant will request rejoinder and examination of additional claims based on the correct relationships as they become relevant.

The August 2005 paper refers to no rule that authorizes grouping the "picture claim" (claim 186) separately from all other groups, and makes no direct response to the challenge raised in Applicant's previous papers. Such a division is unprecedented in Applicant's experience, and failure to "Answer All Material Traversed" renders the requirement nugatory. Applicant suggests that claim 186 should be grouped with Group II.

IV. Election

Applicant elects all claims, as set forth in §§ I and II, above.

In a first alternative election, Applicant elects with traverse one of the groups proposed in November 2004, as modified by "express admissions" that certain claims are obvious with respect to each other. That group includes claims 186-263 and 299-302.

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[4] This discussion is directed to assisting the Examiner in framing an efficient search, and therefore is intended to direct the Examiner to the place where the best prior art is likely to be. It should be understood that this is not a limiting discussion of the invention or the scope of the claims.

In a second alternative, Applicant elects Group II as proposed in August 2005, claims 187-251, 299 and 300, plus claim 186, with traverse.

In a third alternative, Applicant elects Group II as proposed in August 2005, claims 187-251, 299 and 300, with traverse.

V. Conclusion

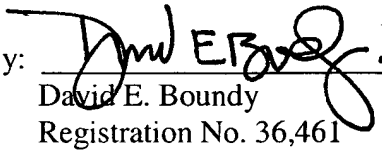
The undersigned attorney is sympathetic to the unfairness that arises because the PTO does not calibrate time budgets to application complexity. However, 37 C.F.R. §§ 10.83-10.89 obligate this attorney to zealously represent his client within the bounds of the law, and to not allow intra-PTO unfairness to translate into unfairness to the client. The Patent Office rules are clear that this application is not properly divided. This attorney will attempt to be fairer than the PTO, and offers all reasonable assistance in getting the application examined. For example, an interview may help in clarifying some of the issues and reducing the work.

In view of these remarks, Applicant respectfully submits that the claims are in condition for examination and allowance. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114459-05.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: December 6, 2005

By: 

David E. Boundy
Registration No. 36,461

WILLKIE FARR & GALLAGHER LLP
787 Seventh Ave.
New York, New York 10019
(212) 728-8757
(212) 728-9757 Fax